

Application No.: 09/625,967
Response Under 37 C.F.R. §1.111 dated July 19, 2004
Response to the Office Action dated February 18, 2004

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1 - 16 are pending in the present application. Claims 1 – 16 stand rejected. The rejections set forth in the Office Action are respectfully traversed below.

Claim Rejections Under 35 USC §103

Claims 1-16 are rejected under 35 USC §103(a) as being unpatentable over Flannery (U.S. Patent No. 6,424,796) in view of Bork et al. (U.S. Patent No. 6,633,932) and further in view of Chan et al. (U.S. Patent No. 6,285,091).

Flannery discloses a personal computer 100 having an adapter 200 for receiving an optical storage medium drive 106 capable of stand-alone playing of an optical storage medium. Power may be supplied to the adapter components 200 from a battery 420 or from an external power supply 422 (column 5, lines 34 - 36 and Fig. 4). As recognized by the Office Action, Flannery does not disclose or suggest a first power input portion being supplied with source power for said expansion device from a power supply for a computer.

Bork et al. is relied upon to teach the above-noted deficiency of Flannery. Bork et al. teach using a universal serial bus (USB) in a computer as a power source for a portable electronic device, such as a cell phone.

Independent claim 1 has been amended to recite a DC/DC converter to which source power is supplied from the first power input portion or the second power input portion depending on

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which power input portion has the higher voltage level. Support for the change to claim 1 is provided, e.g., on page 10, lines 18-22 of the specification.

Neither **Flannery** nor **Bork et al.** disclose a DC/DC converter and switching between power input portions based on a voltage level and providing the higher voltage level to a DC/DC converter.

Furthermore, in rejecting claims under §103, the Examiner must provide a reason why one having ordinary skill in the relevant art would have been lead to combine the prior art references to arrive at the claimed invention. Such reasons supporting the combination must stem from some teaching, suggestion, or incentive in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. However, where no reasonable teaching, suggestion or incentive exists for the proposed combination, a *prima facie* case of obviousness would not have been established.

The Office Action asserts that the motivation for combining **Flannery** with **Bork et al.** is to be able to recharge the batteries in the device of **Flannery** and to not have to purchase new [batteries] as suggested by **Bork et al.**

However, being “able to recharge the batteries in the device of **Flannery**” is in no way connected to receiving source power from a computer. Assuming, *arguendo*, that **Flannery** were designed to recharge the batteries which supply power to the adapter 200, this power could be supplied from any external power source, such as external power supply 422. Thus, there is no need (or suggestion) to receive source power from the computer 100 to perform recharging of

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batteries, and to rely on “being able to recharge the batteries” of the adapter 200 of **Flannery** as motivation for modifying the **Flannery** reference with the teachings of **Bork et al.** is simply hindsight reasoning not suggested by the references. It is respectfully submitted that there is no teaching or suggestion for the combination of **Flannery** and **Bork et al.**, other than that provided by Applicant’s own teachings. Therefore, it is respectfully submitted that any rejection under §103 is improper for at least the reasons set forth above.

Moreover, the Office Action recognizes that the combination of **Flannery** and **Bork et al.** fails to disclose or suggest the claimed supplying of source power to the expansion device from the second power input portion when the second power input portion has a higher voltage level than the first power input portion and supplying source power to the expansion device from the first power input portion when the first power input portion has a higher voltage than the second power input portion (Office Action page 5, lines 1 – 7). The Examiner relies on **Chan et al.** for allegedly disclosing the above-noted features recognized as missing from the combination of **Flannery** and **Bork et al.**.

It is respectfully submitted that **Chan et al.** do not alleviate any of the deficiencies of **Flannery** and **Bork et al.**. First, **Chan et al.** do not disclose or suggest the presently claimed DC/DC converter. Second, **Chan et al.** is related to switching between power sources supplying power to a *single* device, such as portable computing device. More specifically, **Chan et al.** discuss, e.g., switching between AC power supplied by an AC adapter and DC power supplied by a battery to a portable computing device (see, e.g., column 1, lines 10 – 25). **Chan et al.** do not

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disclose or suggest a first power input portion being supplied with source power for an *expansion device* from a power supply for a *computer*, and a second power input portion being supplied source power for the *expansion device* from a second power supply other than the power supply for the computer. In contrast to the present invention, the power supplies of **Chan et al.** (battery and AC source) are supplied to one device (e.g., portable computer), and there is no teaching or suggestion of a power supply for a computer being used as a power supply for an expansion device based on voltage level of the power supply.

Thus, neither **Chan et al.** nor any of the other cited references disclose or suggest selectively supplying power to an *expansion device* from a power supply for a computer or from a power supply other than the power supply for the computer based on which power supply has a higher voltage level.

Therefore, in view of the above remarks, it is respectfully submitted that neither **Flannery, Bork et al.** nor **Chan et al.**, whether taken alone or in combination, disclose, suggest, or render obvious the presently claimed invention. Further, it is respectfully submitted that proper motivation for combining the references under §103 has not been provided, and therefore a *prima facie* case of obviousness under §103 has not been established. Reconsideration and withdrawal of the rejections of claims 1 – 16 under §103 are respectfully requested.

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CONCLUSION

For the reasons set forth in detail above, it is respectfully submitted that all pending claims are in condition for allowance. An indication of allowability of all pending claims is respectfully requested.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

In the event that any fees are due in connection with the filing of this paper, please charge any fees to Deposit Account No. 50-2866.

Respectfully submitted,

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Enclosure: Petition for Extension o f Time
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